

REMARKS

These remarks are responsive to the non-final Office action dated January 17, 2008, and are being filed under 37 C.F.R. § 1.111. Claims 28–30, 33–41, 83, 84, 88, and 89 are pending in the application, although the Examiner failed to list claims 34–36 and 84 in the Office Action Summary. Claim 83 is the only independent claim. In the Office action, the Examiner rejected each of the pending claims as follows:

- Claims 83, 28–30, 37–41, 88, and 89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,331,392 to Laing et al. ("Laing") in view of U.S. Patent No. 6,806,053 to Sportsman et al. ("Sportsman"); and
- Claims 33–36 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Laing in view of Sportsman and further in view of U.S. Patent No. 6,586,193 to Yguerabide et al. ("Yguerabide").

Applicants traverse the rejections, contending that none of the pending claims is obvious. In particular, applicants believe that one of the references (Sportsman) cited in each of the rejections is not prior art to the pending claims. Accordingly, applicants respectfully request reconsideration of the application in view of the remarks below, and prompt issuance of a Notice of Allowance covering all of the pending claims.

I. Sportsman is Not Prior Art

Applicants believe that Sportsman should not be used to reject any of the pending claims because (1) Sportsman is not prior art under 35 U.S.C. § 102(e) or any other subsection of Section 102, and (2) even if Sportsman were prior art under 35 U.S.C. § 102(e), which applicants contend it is not, Sportsman is disqualified under 35 U.S.C. § 103(c)(1) from being used in an obviousness rejection.

The Examiner did not cite a specific subsection of Section 102 under which Sportsman would serve as prior art. However, the following discussion focuses on 35

U.S.C. § 102(e) because applicants contend that the remaining subsections of 35 U.S.C. § 102 (i.e., subsections (a)-(d), (f), and (g)) are even less relevant to any assertion that Sportsman is prior art.

The present application was filed in the U.S. Patent and Trademark Office on January 23, 2001, and claims priority to PCT Patent Application Serial No. PCT/US99/24707, filed October 19, 1999 ("the '707 application"), which in turn claims priority from two U.S. provisional patent applications: Serial No. 60/104,964, filed October 20, 1998; and Serial No. 60/126,661, filed March 29, 1999. The present application and the '707 application have substantially identical disclosures and thus every pending claim of the present application should have an effective filing date of October 19, 1999, if not earlier.

Sportsman was filed in the U.S. Patent and Trademark Office on January 23, 2001, that is, on the same day as the present application, and issued as a patent on October 19, 2004. Sportsman claims priority to several earlier-filed applications, namely, PCT Patent Application Serial No. PCT/US00/16012 ("the '012 application"), filed June 9, 2000, and three U.S. provisional patent applications filed, respectively, June 9, 1999 ("first provisional patent application"), February 11, 2000 ("second provisional patent application"), and April 28, 2000 ("third provisional patent application"). However, neither the '012 application nor any of the first, second, and third provisional patent applications give Sportsman a U.S. filing date before the priority date of October 19, 1999, provided by the '707 application. In particular, the '012 application, as an international application, does not have a U.S. filing date for prior art purposes under 35 U.S.C. § 102(e) because it was not filed on or after November 29, 2000 (see MPEP § 2136.03(II)). Furthermore,

the '012 application, because it was filed prior to November 29, 2000, "may not be used to reach back (bridge) to an earlier filing date to a priority or benefit claim for prior art purposes under 35 U.S.C. § 102(e)" (MPEP § 2136.03(III)). Therefore, the '012 application cannot be used to reach back to the first provisional patent application, which was filed more than one year before Sportsman's actual U.S. filing date. As a result, Sportsman has a reference date under 35 U.S.C. § 102(e) of January 23, 2001 (the actual filing date), February 11, 2000 (the filing date of the second provisional patent application), or April 28, 2000 (the filing date of the third provisional patent application), but not earlier, and thus not before the present application's priority date of October 19, 1999, provided by the '707 application. Therefore, Sportsman is not prior art to the present application under 35 U.S.C. § 102(e).

Even if, for the sake of argument, Sportsman were prior art to the present application under 35 U.S.C. § 102(e), and applicants maintain that Sportsman is not, Sportsman is disqualified by 35 U.S.C. § 103(c)(1) from being used in an obviousness rejection. This subsection of Section 103 reads as follows:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person and were subject to an obligation of assignment to the same person.

Here, the subject matter of Sportsman cited by the Examiner and the claimed invention were, at the time the claimed invention was made, owned by L JL Biosystems, Inc., or were subject to an obligation of assignment to L JL Biosystems, Inc. In support of this assertion, Sportsman was assigned to L JL Biosystems, Inc., in August, 2000, as

Biosystems, Inc., in December, 1999, as recorded at Reel/Frame 011473/0194.

Therefore, even if Sportsman were prior art under 35 U.S.C. § 102(e), and applicants maintain that Sportsman is not prior art, Sportsman should not preclude patentability of the claimed invention under 35 U.S.C. § 103(a).

Each of the pending claims was rejected over Sportsman in combination with one or more other references. Since Sportsman should not be cited as prior art, applicants respectfully request withdrawal of all rejections under Section 103.

II. Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowance covering all of the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record, or his associate, Stan Hollenberg (Reg. No. 47,658), both at (503) 224-6655.

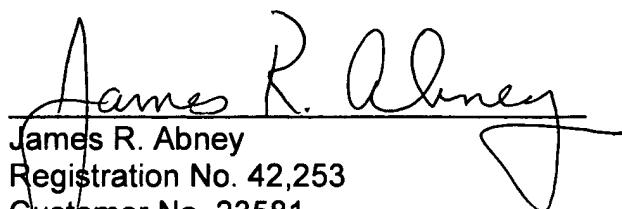
Respectfully submitted,

KOLISCH HARTWELL, P.C.

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